



1906/003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : LOWENSTEIN, Douglas G.
Serial No.-Conf. No. : 09/611,548 - 6763
Filed : July 7, 2000
For : FINANCING OF TENANT IMPROVEMENTS
Examiner : N. Subramanian
Group Art Unit : 3691

SUMMARY OF TELEPHONIC INTERVIEW
WITH EXAMINER KYLE
ON AUGUST 18, 2010 BY DONNA L. ANGOTTI

1. On August 18, 2010, I, Donna Angotti, had a telephonic interview with Examiner Kyle regarding the Office Action of February 19, 2010, and requested withdrawal of the Office Action of February 19, 2010 since it did not examine the claims as amended and did not answer all material traversed.

2. Examiner Subramanian was on vacation.

3. I explained that the Office Action of February 19, 2010 is designated a non-final action and that the Petition decision issued on March 30, 2010 stated that the finality of the case was improper.

4. I argued that Applicant is entitled to have any amendments to claims presented entered as of legal right as long as the application is not finally rejected.

5. I argued that the Amendment and Reply to Office Action of November 5, 2009 should have been entered. Therefore, the correct claims as amended are in Claims Appendix Two of that filing.

6. I argued that the Patent Office has not entered the Amendment of the claims in Claim Appendix Two of the filing of November 5, 2009 and has not examined

the claims as amended. I noted that there is no express statement in the Office Action of February 19, 2010 that the claim amendments in Claim Appendix Two of the filing of November 5, 2009, were entered or considered.

7. I stated that it is clear from the Action that the Examiner did not consider the claim amendments.

8. I argued that the Office has erred by not considering the claims as amended November 5, 2009.

9. I pointed out that Applicant is now in the position of responding to an Office Action that did not even address the correct claims. This further complicates a case that has already been pending for 10 years and is already procedurally complicated.

10. I argued that the procedure in the case will be simplified if the Office Action of February 19, 2010 is withdrawn.

11. I argued that furthering the prosecution of the wrong claims is futile and a waste of time, effort and money; but the Office has subjected the Applicant to this burden, including PTO fees and attorney fees.

12. I requested that SPE Kyle relieve the Applicant of this unfair burden by withdrawing the February 19, 2010 Action in a one or two sentence fax communication to me.

13. I requested the Office to send a new Office Action considering the correct set of amended claims.

14. I felt that this was the sort of issue that could easily be resolved by contacting the Patent Office and explaining the problem, so that the Office Action could

be withdrawn without Applicant having to go through the onerous and expensive task of responding to an Office Action that does not even address the correct set of claims.

15. I explained that it is expensive in terms of Patent Office fees and attorney fees for a response to be prepared and filed.

16. I explained that a response would cost the Applicant thousands of dollars.

17. I pointed out that this was an economic recession.

18. I had contacted the Patent Office (SPE Klye) by email on August 10, 2010 to alert him to the issue earlier explaining some of my arguments.

19. I offered to walk SPE Kyle through this fairly simple procedural issue including the relevant portions of the papers such as the requests that the amendments be entered, the withdrawal of finality in the Office Action and the Decision of March 30, 2010, and the portions of the Office Action which seem to not be aware of the amended claim language.

20. I estimated that it would only take a few minutes.

21. SPE Klye refused to withdraw the Office Action and required the Applicant to file a written response at great expense to the Applicant.

22. I explained that the issue was being raised so late in the extended period for response because the case would be considered by some to be a “business method” case. The Supreme Court of the United States recently issued a decision in the *Bilski* case on the issue of whether business methods are eligible for patent protection. That decision was issued on June 28, 2010, well into the extended period for response for this case. As Applicant’s counsel, I reasonably did not respond in this case until seeing the outcome in the *Bilski* case. Had the Supreme Court ruled differently than it did, and had

it held that business methods are never eligible for patent protection, the application may not have been pursued. It is a practical matter of practicing law that an attorney should not bill any significant amount of time reviewing a case when there is a significant chance that a court decision will soon be issued wiping out any possibility of patent protection. Thus, the case was not significantly reviewed and the issue was not addressed earlier. I was reasonable in not intentionally jacking up the Applicant's legal bills in times of an economic recession without knowing the outcome of the *Bilski* case.

23. SPE Kyle refused to consider the issue and make a decision. He said he had consulted a quality assurance specialist, Lana Mai, before speaking with me based upon the email I had sent. Apparently, his decision to not make a decision on the issue in time to save the Applicant the financial burden of responding, was made before even speaking with me, and there was nothing I could say to change his mind.

24. He agreed that he was the decision maker and not Lana Mai.

25. He asserted that he did not have time to review the matter and wanted to speak to the examiner who was on vacation.

26. He agreed that he was the examiner's boss and was the ultimate decision maker with the authority to make the decision without speaking to the examiner.

27. Because he did not have a few minutes to walk through the relevant portions of the papers with me on the phone, the Applicant had to pay me for hours of work to respond to an Office Action that does not even address the amended claims.

28. I expressed my opinion that I was getting a run around and that I thought the situation was outrageous.

29. I feel the error could have been easily resolved by SPE Kyle withdrawing the Office Action by taking five minutes to type and to fax a statement of withdraw to me.

30. I pointed out that if he "erroneously" withdrew the Office Action, the worst case scenario was that the examiner would simply resend the office action upon returning from vacation.

31. I felt that SPE Kyle was knowingly and intentionally increasing Applicant's legal fees unnecessarily.

32. I feel that this situation amounts to abuse of the administrative legal process.

Respectfully submitted,

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By: 

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Dated: August 19, 2010
New York, New York